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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,313	08/17/2001	Hennie Wesseling	BO 44439 JGD	6559

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EXAMINER	
AGWUMEZIE, CHARLES C	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/856,313	WESSELING ET AL.	
	Examiner	Art Unit	
	Charlie C. Agwumezie	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/17/01*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-9 and 12-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-9 and 12-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/21/01 & 01/13/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1 and 2 are cancelled. Independent claims 1 and 10 have been replaced with new claims 19 and 22. Claims 2 and 11 have been replaced with new claims 20-21 and 23-24. Claims 3-9 and 12-18 have been amended. Claims 3-9 and 12-24 are pending in this office action per response to office action filed by applicant on March 10, 2005.

Response to Amendment

With respect to the claims, applicant's amendments filed on March 10, 2005 have been fully considered but are moot based on the new grounds of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 3-9 and 12-24 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-23 of U.S. Patent No. 6,851,619 in view of Eckert U.S. Patent 4,649,266.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim I of U.S. Patent No. 6,851,619 recites:

- A method for producing and printing a franking mark on a postal article, comprising:

(a) generating and storing a set of unique bit strings in the first memory in the central office connected to a plurality of terminals;

(b) making available one or more of said unique bit string to one of said terminals;

(c) establishing an identical code;

(d) transmitting data including a copy of the said unique bit string in combination with said identification code to said central, and storing said data in a second memory;

(e) generating a franking mark which at least comprises information relating to one of said unique bit strings and identification code, and

(f) securely printing the franking mark on the postal article.

Claim 1 of the U.S. Patent No. 6,851,619 differs since it failed to recite additional claim limitations as recited in independent **claims 19 and 22,** of current application, including:

Reading the franking mark after the franking mark has been printed on the document, the franking mark including an encoded identification code and an encoded unique bit string;

Decoding the franking mark to render a decoded identification code and a decoded unique bit string;

Checking whether the decoded identification code is correct by comprising the decoded identification code to the identification code stored in the second memory; and

Checking whether the decoded unique bit string is valid by comparing the decoded unique bit string to the unique bit string stored in the second memory.

Eckert discloses a method for checking a franking mark comprising:

Reading the franking mark after the franking mark has been printed on the document, the franking mark including an encoded identification code and an encoded unique bit string (col. 3, lines 5-15);

Decoding the franking mark to render a decoded identification code and a decoded unique bit string (col. 3, lines 15-25);

Checking whether the decoded identification code is correct by comparing the decoded identification code to the identification code stored in the second memory (col. 3, lines 15-25)

Checking whether the decoded unique bit string is valid by comparing the decoded unique bit string to the unique bit string stored in the second memory (col. 3, lines 15-25).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of U.S. Patent No. 6,851,619 and incorporate the ability to reading of the franking mark and decoding of the franking mark as taught by Eckert in order to further verify and ensure validity of the mail piece.

3. As per **claim 3 and 12**, U.S. Patent 6,851,619 discloses a method in which the franking mark comprises a terminal identification code associated with the one terminal (see claim 3).

4. As per **claim 4 and 13**, U.S. patent No. 6,851,619 further discloses a method in which the identification code comprises at least one of a user identification code and a printing identification code, said printing identification code being associated with a printing device which print the franking mark (see claim 8).

5. As per **claim 5, 6, and 15,** U.S. Patent 6,851,619 failed to explicitly disclose a method in which the franking mark comprises a combination of the unique bit string and a counter value and the method also comprises the steps of

checking whether the combination occurs in the second memory and, if so, then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid.

Eckert discloses a method in which the franking mark comprises a combination of the unique bit string and a counter value (the seed number resident in the decoder and performing a decoding and encryption algorithm with one or more of the parameters e.g. serial number, the date, the piece count etc determines validity of the mark if there is a match) and the method also comprises the steps of

checking whether the combination occurs in the second memory and, if so, then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid (col. 3, lines 20-25).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of U.S. Patent No. 6,851,619 and incorporate a method in which franking mark comprises a combination of the unique bit string and a counter value as recited in claim 6 and as taught by Eckert in order to further check the validity of the mail piece.

6. As per **claim 9 and 18**, U.S. Patent No. 6,851,619 expressly show a method in which the franking mark is located on a postal article but failed to show for the sake of

delivery is sorted in at least a first and thereafter a second sorting center, and in which steps a and b are executed in the first sorting center and the information obtained therefrom is sent to a checking center, after which the two checking steps are executed in the checking center prior to sorting in the second sorting center.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The sorted in at least a first and thereafter a second sorting center, would be performed the same regardless since the post office does various sorting depending on the mail piece involved. Thus, this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the mail will be sorted depending on the mail piece involved because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

20. As per **claim 20 and 23**, U.S. Patent No. 6,851,619 further discloses the method wherein the unique bit string in combination with the identification code are protected by a message Authentication code and the method includes the step of checking the message Authentication code (see claim 3 and 14).

20. As per **claim 21 and 24**, U.S. Patent No. 6,851,619 further discloses the method wherein the unique bit string in combination with the identification code are protected by encoding and the method includes the step of checking the encoding (see claim 13).

11. **Claim 7 and 16**, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,851,619 in view of in view of Eckert U.S. Patent 4,649,266 as applied to claim 1 above, and further in view of Pastor U.S. Patent 5,390,251.

12. As per **claim 7 and 16**, U.S. Patent No. 6851619 and Eckert failed to disclose the method in which also is checked whether a period of validity associated with the franking mark has expired.

Pastor discloses the method in which also is checked whether a period of validity associated with the franking mark has expired (col. 4, lines 28-34).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of U.S. Patent No. 6,851,619 and Eckert and incorporate a method in which also is checked whether a period of validity associated with the franking mark has expired as taught by Pastor in order to ensure validity of the mail piece.

13. **Claim 8,** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,851,619 in view of in

view of Eckert U.S. Patent 4,649,266 as applied to claim 1 above, and further in view of Peyret U.S. Patent 5,688,056.

14. As per **claim 8**, U.S. Patent No. 6,851,619, Eckert failed to explicitly disclose a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark.

Peyret discloses a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark (col. 8, lines 1-7)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of U.S. Patent No. 6,851,619 and Eckert and incorporate a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark as taught by Peyret in order to show alternative method of payment.

11. **Claim 14**, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,851,619 in view of in view of Eckert U.S. Patent 4,649,266 as applied to claim 1 above, and further in view of Gilham U.S. Patent 6,308,165.

10. As per **claim 14,** U.S. Patent No. 6,851,619 failed to explicitly disclose the system in which the franking mark comprises a combination of the unique bit string and a counter value, and the system also comprises means for:

subtracting the counter value from the remaining counter value stored with the unique bit string in second memory and checking whether the remaining counter value amounts to more than zero, and if so, then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid.

Gilham discloses the system in which the franking mark comprises a combination of the unique bit string and a counter value, and the system also comprises means for:

subtracting the counter value from the remaining counter value stored with the unique bit string in second memory and checking whether the remaining counter value amounts to more than zero, and if so, then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid (col. 4, lines 7-25).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of U.S. Patent No. 6,851,619 and Eckert and incorporate a method in which franking mark comprises a combination of the unique bit string and a counter value as recited in claim 14 and as taught by Gilham in order to further check the validity of the mail piece.

15. **Claim 17**, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,851,619 in view of in

view of Eckert U.S. Patent 4,649,266 and in view of Gilham U.S. Patent 6,308,165 as applied to claim 14 above, and further in view of Peyret U.S. Patent 5,688,056.

16. As per **claim 17**, U.S. Patent No. 6,851,619, Eckert and Gilham, failed to explicitly disclose a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark.

Peyret discloses a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark (col. 8, lines 1-7)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of U.S. Patent No. 6,851,619 and Eckert and incorporate a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark as taught by Peyret in order to show alternative method of payment.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art ad are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is (703) 305-0586. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305 – 9768. The fax phone number for the organization where the application or proceeding is assigned is (703) 305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

acc
May 18, 2005

JOHN W. HAYES
PRIMARY EXAMINER